

REMARKS

Claims 27 and 28 are added, and therefore claims 11, 12, 14, 15 and 18 to 28 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4) of the Office Action, claims 11, 12, 14, 15, and 21 to 23 were rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Publication No. JP 2002-084119 (the Asakawa reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 11 relates to a window-integrated antenna for a vehicle, including the feature in which at least one of a length and a position of the at least one decoupling element is arranged so that a resonant impedance behavior occurs in the FM frequency range at a connection end of the decoupling element.

The Asakawa reference merely refers to conductor wires 24 having a particular length. Specifically, the Asakawa reference indicates “conductor wires 24 [that] are one fourth of the length of the wavelength in the glass of the signal of the frequency which is near high [or low] frequency band VHF_H [or VHF_L] of VHF television broadcasting band from an

FM radio broadcast band.” (Asakawa, ¶ [0021]; and Figure 1). In this manner, an “[i]nput-signal X2 of an FM radio broadcast band, and VHF and a UHF television broadcasting band is outputted.” (Asakawa, ¶ [0022]; and Figure 1). However, nowhere does the Asakawa reference identically disclose (or even suggest) the feature of arranging at least one of a length and a position of the at least one decoupling element so that a resonant impedance behavior occurs in the FM frequency range at a connection end of the at least one decoupling element, as provided for in the context of the presently claimed subject matter.

Indeed, the Asakawa reference does not even mention causing a resonant impedance behavior, must less causing a resonant impedance behavior at a connection end of the decoupling element. Further, the Asakawa reference merely refers to affecting impedance via coil 57 and capacitors 58, 59, which filter the input signals. (Asakawa, ¶ [0025]; and Figure 2). Thus, the Asakawa reference does not identically disclose (or even suggest) the feature in which at least one of a length and a position of the at least one decoupling element is arranged so that a resonant impedance behavior occurs in the FM frequency range at a connection end of the decoupling element, as provided for in the context of claim 11.

Accordingly, it is respectfully submitted that claim 11 is allowable. Claims 12, 14, 15, and 21 to 23 depend from claim 11 and are therefore allowable for at least the same reasons as claim 11.

Accordingly, it is respectfully submitted that claims 11, 12, 14, 15, and 21 to 23 are allowable.

Withdrawal of the anticipation rejections of the claims is therefore respectfully requested.

With respect to paragraph six (6) of the Office Action, claims 18, 19, 24, and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Asakawa reference, in view of U.S. Patent Application Publication No. 2004/0056810 (the Oka reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Asakawa reference does not disclose or even suggest all of the features of claim 11. Claims 18, 19, 24, and 25 depend from claim 11 and are therefore allowable for essentially the same reasons provided above, since the Oka reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Asakawa reference. In this regard, it is believed and respectfully submitted that the Oka reference does not in any way disclose or even suggest the claim feature as to the resonance characteristics for antenna elements 51 and 52 (which are also called independent antenna elements in Oka, and not “decoupling elements”).

Withdrawal of the obviousness rejections is therefore respectfully requested.

With respect to paragraph seven (7) of the Office Action, claims 20 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Asakawa and Oka references, in view of U.S. Patent No. 6,201,506 (the Endo reference).

As explained above, the combination of the Asakawa and Oka references does not disclose or even suggest all of the features of claim 11. Claims 20 and 26 depend from claim 11 and are therefore allowable for essentially the same reasons provided above, since the Endo reference does not cure -- and is not asserted to cure -- the critical deficiencies of the combination of the Asakawa and Oka references.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide

specific evidence to establish those assertions and/or contentions that may be supported by that Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

New claims 27 and 28 do not add any new matter and are supported by the present application, including the specification. Claims 27 and 28 depend from claim 21, and are therefore allowable for the same reasons. Additionally, each of claims 27 and 28 include further features that are not disclosed or suggested by the applied references.

In sum, claims 11, 12, 14, 15 and 18 to 28 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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